

REMARKS

As suggested by Examiner Chu and Gartenberg in a personal interview of October 15, 2010, the claims have been amended to include structural limitations which distinguish over the prior art. In particular, Markovics does not disclose a disposable product, does not show forming a multiplicity of individual portions from an elongate web, does not show frangible zones as a means of integrally connecting together neighboring individual portions, does not envisage allowing its individual portions to be torn away from each other, and does not show connection in a stack only by frangible zones. Franco does disclose a disposable product, shows forming a multiplicity of individual portions from an elongate web, shows frangible zones as a means of integrally connecting together neighboring individual portions, envisages allowing its individual portions to be torn away from each other, and shows connection in a stack only by frangible zones. However, Franco does not show a folding pattern for circular shaped individual portions and in particular, does not show a plurality of diametric fold lines to form a quadrant shaped stack. Also, whilst Franco refers to the possibility of individual portions having a generally circular shape, it advises against this on grounds that it is wasteful of material.

Although Markovics shows foldable sheets 26 each formed by panels 28, 30, 32 and 34 along diagonal fold lines 41 and "joined together in strip fashion", Markovics discloses the rear surfaces of panels of adjacent sheets are affixed so closing one sheet 26 will open the next sheet 46 and specifically does not disclose that such foldable sheets 26 are attached in series by frangible zones of material all lying on a longitudinal axis to form an elongate web. In fact, it would be against the teachings of Markovics to attach foldable sheets 26 as an elongate web and would destroy the operation of an album as set forth at column 4, line 53 and following of Markovics to do so. Thus, it should be appreciated that Markovics provides no teaching or suggestion as to how to fold a web of material comprising a multiplicity of individual portions integrally connected together in series by frangible zones lying on a longitudinal axis and/or where to locate the frangible zones in relation to the quadrant shape and/or in relation to the fold lines in a manner as recited in the claims of the present application. In particular, the only teaching of Markovics that is being relied upon is fold lines, and all of the other teachings of Markovics must be ignored and disregarded. It is then respectfully submitted that the present rejection is a piecemeal reconstruction of the prior art utilizing the hindsight knowledge of the present invention for several reasons. Initially, it is respectfully submitted that Markovics is non-

analogous art. In this regard, form paragraph 7.37.05 Unpersuasive Argument: Nonanalogous Art of the MPEP indicates:

In response to applicant's argument that [1] is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, [2].

The facts of the Oetiker case are:

Oetiker's invention is an improvement in a "stepless, earless" metal clamp, a hose clamp that was generally described in an earlier '004 patent of Oetiker, but that differs in the presence of a feature that is described as a preassembly "hook". This "hook" serves both to maintain the preassembly condition of the clamp and to be disengaged automatically when the clamp is tightened.

The cited references were Oetiker's earlier-granted '004 patent, combined with a certain Lauro '004 patent. Lauro describes a plastic hook and eye fastener for use in garments, in which "unitary tabs of sewing needle puncturable plastic material ... are affixable to clothing and the like by sewing".

* * *

The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The examiner explained further by stating that "Appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the examiner's argument, or discuss its relevance. Indeed, the argument is not supportable. However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention.

The Board apparently reasoned that all hooking problems are analogous...

The Court of Appeals for the Federal Circuit reversed the Board of Appeals in Oetiker stating:

...We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036,202 USPQ 171, 174 (CCPA 1979)--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or

motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed.Cir.1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed.Cir.1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147,227 USPQ 543, 551 (Fed.Cir.1985).

Relying upon Oetiker, Examiner Chu contends:

...In this case, an inventor considering different fold methods and folds for disposable paper products would naturally look to references employing other "paper folds, album cover folds, pop-up type books, etc." which in that case came from areas such as "cassette storage, storage for discs/albums, books, binders, etc."...

Examining the elements of this contention, it is respectfully submitted that the word "naturally" is a concession that the prior art does not provide "some reason, suggestion, or motivation..." whereby a person of ordinary skill in the field of the invention would make the combination", as required in Oetiker. Clearly, if a reason, suggestion or motivation did exist in the prior art, Examiner Chu would have identified it. Thus, this requirement of Oetiker is not met by Examiner Chu.

Further, Markovics shows an album or book assembly which are not considered "disposable" and would not be a "disposable paper product". It is respectfully submitted that albums and book assemblies are not within the specific field of endeavor of disposable paper products.

More importantly, it is respectfully submitted that contending "considering different methods and folds" is exactly the same reasoning of the Board in Oetiker when it considered different hooking methods and hooks to be analogous. It is not reasonable to expect a person of ordinary skill to look in folded non-absorbent material, but, more importantly, it is not reasonable to expect a person of ordinary skill to look in folded material which is not in the form of an elongate web. There cannot be an expectation that a fold method and folds in material which is not in the form of an elongated web could be applied to material in the form of an elongated web and could be predicted to yield results when attempting to fold elongated webs. In reality, it would not be common sense for a person skilled in the art attempting to fold an

elongated web of absorbent material to look at albums and book assemblies except by utilizing hindsight in reconstructing the invention. Thus, it is respectfully submitted that the rejections of the claims based upon Markovics have been overcome. Favorable reconsideration is respectfully requested.

Furthermore and even assuming that Markovics is analogous art, as set forth in the Oetiker case, only the present application provides any rationale whereby a person of ordinary skill would make the combination. The applicants came to the realization that *if* extra trouble was taken to produce wipes in a circular shape, fold them into a quadrant form and present them in a quadrant shaped stack, *then* this would create advantages in terms of storage and dispensing. Only the hindsight knowledge of the present invention provides the appreciation that there was an alternative and possibly better way of presenting a disposable wipe. The steps taken by the applicants to achieve this basically went against conventional wisdom. For example, the applicant chose to produce wipes in a circular shape, despite Franco's teaching that square is preferred. Also, whereas Franco teaches a comparatively simple parallel folding pattern, which is relatively easy to effect on a production line, the applicants chose to form wipes with a plurality of diametric fold lines, a much more complicated folding pattern to effect on a production line. Even if such a folding pattern is seen in the completely different product taught by Markovics, why would anyone consider applying it to Franco, and in particular, to the shape which Franco says is wasteful? Common sense suggests that it would not be a good idea, because it would simply introduce unnecessary complication for no obvious benefit. In short, the Examiner has not identified any motivation in the prior art for extracting a folding pattern out of an unrelated field of art and applying it to a product in another field that could justify his obviousness objection.

More particularly, although Franco indicates "circles of tissue" would be useful, Franco expressly teaches "in the interest of economy of manufacture squares are desirable because there is substantially no cutting waste" (column 1, lines 66-68 of Franco, emphasis added). There is nothing in Markovics that would provide a motivation that the desirable square shape which is expressly taught in Franco should be ignored and/or that there would be any advantage of doing so which would offset the loss of "no cutting waste" advantage of Franco. More importantly, Franco provides no teaching or suggestion that it is deficient, that further improvement is possible, and/or that the tissues could be folded in other manners. Likewise, Markovics only

teaches radially extending fold lines, with all of its other teachings being contrary to the teachings of Franco (and the recitations of the claims of the present application.) It should then be immediately appreciated that neither Franco nor Markovics teaches locating the frangible zones on the longitudinal axis of the web and/or on the curved part of the quadrant shape, and, thus, their combination cannot result in something that is absent from both. Therefore, it is respectfully submitted that the present rejections under 35 U.S.C. § 103 are improper for these separate and independent reasons.

Additionally, it is respectfully submitted that the Examiner cannot pick and choose elements from Markovics to the exclusion of the other elements taught therein. As stated by the CCPA in In re Kamm and Young, 172 USPQ298 at 301 and 302:

The rejection here runs afoul of a basis mandate inherent in Section 103--that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. *In re Rothermel*, 47 CCPA 866, 870, 26 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965). We think this has been done here.

We appreciate the relative ease with which one can slip into such an error, especially where, as here, the primary reference addresses the same problem as appellants and solves it using merely a different chemical agent. However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made.

An object of the invention of Markovics is "...to provide such an album in which, with a single turn, a subsequent sheet is unfolded automatically while the immediately preceding sheet is being closed." (column 1, lines 35-38 of Markovics). Only the hindsight knowledge of the present invention would suggest that the folding methods and folds of Markovics could be chosen while excluding the structural features resulting in the expressly taught function of automatic unfolding and closing. Applicants then believe that the Examiner has slipped into the improper picking and choosing of components of the references in a similar manner as in the

Kamm decision. Therefore, it is submitted that the present rejections under Section 103 are improper for these separate and independent reasons.

Likewise, it is respectfully submitted that the Examiner is focusing his inquiry on the differences of the present invention from Franco and not on the invention as a whole, in the same manner that the lower court did in Connell v. Sears, Roebuck & Co., 220 USPQ 193 (1983). In the Connell decision, the CAFC indicated on pages 198 and 199 that focusing on distinguishing features was improper stating:

It bears repeating...the following limited portions... are deemed sufficiently misdirected to require discussion. * * *

The opinion says obviousness is established when "features that distinguish" the invention from the closest reference "are disclosed in analogous structures in which the features perform an identical function." It is not "features" but the subject matter of the invention "as a whole" that must be considered, 35 U.S.C. § 103. That features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. § 103.

Likewise, the CAFC in Carl Schenck, A.G. v. Nortron Corp., 218 USPQ 698, 700 (1983) indicated:

Nortron seeks to limit the focus of inquiry to a structural difference from the prior art and then to show that difference **alone** would have been obvious. That effort is not proper under the statute, which requires that an invention be considered "as a whole"... (emphasis theirs)

Applicants do not contend they are the first to invent folding plies per se or a multiplicity of individual portions integrally connected together by frangible zones. Rather, applicants recognized the possibility of a different and better way of presenting wipes which minimized the amount of material used to make the plies resulting in cost effectiveness and environmental friendliness which had not been satisfied by conventional disposable wipes. It is respectfully submitted that the combination of elements which has proven to be serviceable to a need which was not articulated in either Markovics and Franco, is not suggested by the prior art, required a high degree of originality, and would not be obvious to a person of ordinary skill in the art. As stated by Judge Hand in B.G. Corp. v. Walter Kidde & Co., 79 F.2d 20, 22, 26 USPQ 288, 289-290 (2d Cir. 1935):

All machines are made up of the same elements; rods, pawls, pitmans, journals, toggles, gears, cams, and the like, all acting their parts as they always do and always must. * * * But the elements are capable of an infinity of permutations and the selection of that group which proves serviceable to a given need may require a high degree of originality. It is that act of selection which is the invention * * *

The Examiner's contentions that both the connection between plies and the folding of plies were separately known is in fact a concession that the present invention is not disclosed in the prior art. Further, it is respectfully submitted that these contentions of the Examiner do not establish obviousness, but it is necessary to do the objective analysis for determining obviousness stated in Graham v. John Deere reaffirmed in KSR International, namely by resolving the level of ordinary skill in the pertinent art as well as providing a rational to support rejection under 35 U.S.C. § 103. As set forth in **Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 In View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register**, Vol. 72, No. 195, October 10, 2007:

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* stated that “ ‘[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ”

In this regard, how does Markovics provide any disclosure of “ease of manufacture” of elongated webs when Markovics does not disclose elongated webs and which of the “variety of attractive shapes and configurations” of Markovics would be or could be used in elongated webs. It should be appreciated that the reasons given are mere conclusory statements and do not provide any articulated reasoning why the “separately known” features could be combined by a person of ordinary skill and more importantly would be combined in the manner as recited in the claims to be serviceable to a need which was not articulated and was deficient in both references. Thus, it is respectfully submitted that the present rejections under 35 U.S.C. § 103 are improper for these separate and independent reasons. Favorable reconsideration is respectfully requested.

Furthermore, as Markovics does not teach or disclose a web having frangible zones, how can Markovics teach or disclose the arrangement of fold lines relative to the longitudinal axis extending through the frangible zones which are located on the curved part of a quadrant shape

as recited in claims 23-25, 29-32 and 38 of the present application. Thus, it is respectfully submitted that the rejections of claims 23-25, 29-32 and 38 have been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Additionally, it is agreed that Abbosh D447,346 shows a diametric fold line (which is absent from both Markovics and Franco), but does not show such a diametric fold line aligned with the longitudinal axis of a web. Further, Abbosh D447,346 does not show the first, second and third fold lines as recited in the claims from which claims 25 and 31 depend. Furthermore, including additional fold lines would prevent the interwoven stacking of Figures 8, 9, 17 and 18 of Abbosh D447,346. Summarizing, a total of three fold lines are disclosed in Markovics. Thus, folding along four fold lines as recited in claims 25 and 31 is clearly not disclosed in Markovics. A total of one fold line is disclosed in Abbosh D447,346. Thus, folding along four fold lines as recited in claims 25 and 31 is clearly not disclosed in Abbosh D447,346. Furthermore, there is nothing in Markovics which would suggest the possibility of folding along four lines is possible, desirable, or could yield predictable results. Similarly, there is nothing in Abbosh D447,346 which would suggest the possibility of folding along three additional lines, and folding along more than one fold line clearly would prevent the expressly taught interweaving. The only rationale which would support attempting to reconstruct the present invention by combining Markovics and Abbosh would be the hindsight knowledge of the present invention. Thus, the rejection of claims 25 and 31 has been overcome for this separate and independent reason.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' Disposable Wipe Product, which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and by the applicants, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 3, 5, 9, 10, 12-14, 23-25, 29-32 and 34-38, as amended, of the present application and to pass this application to issue.

In view of the foregoing remarks, it is believed that the application is now in condition for allowance and such action is respectfully requested. If any points remain in issue which the Examiner feels could best be resolved by either a personal or telephone interview, the Examiner is urged to contact Applicants' attorney at the exchange listed below.

Respectfully Submitted,
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